

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCESRegarding: Leslie E. Smith et al.
Serial No. 10/743,936
Filing Date 12/23/2003
For FORMATION OF WIDE PAINT FILM PARTSRECEIVED
CENTRAL FAX CENTER
FEB 23 2006Reply BriefAttention: Appeal from Group Art Unit 1732
Examiner Monica A. Fontaine
Supervisory Primary Examiner Michael P. Colaianni

Commissioner for Patents, Alexandria, VA 22313-1450:

I certify that this correspondence is facsimile-transmitted
to the Patent and Trademark Office (571 273 8300) on 23 FEB 2006:Christopher John Rudy: *Christopher John Rudy* 23 FEB 2006.Please consider the present reply brief in reply to the
01/11/2006 Examiner's Answer. Reply arguments are taken in turn
to the Examiner's Answer, from its page 4 through its page 5.Reply Argument

It does not follow that because the deformable material of Peterson could be painted, his disclosure could (much less does) suggest a deformable paint film. Stretching of a paint film, which has "paint" in it before stretching, is fundamentally different than painting a part after stretching is complete. Moreover, Peterson's disclosure is primarily employed to make aircraft windshields, which are not painted, thus teaching away.

Susa et al. does not contemplate such stretching as claimed hereby. The "stretching" in Susa et al., again, is undesirable and is noted to occur on contours of molded articles. In order to solve this problem, Susa et al. directed their work to finding new and different materials, not stretching of paint film stock.

Neither Peterson nor Susa et al. teaches nor suggests precursors and parts that can be wider than sheets, and the claims do require such limitations. See, claim 10, lines 22-25, which recites, "... so as to draw or stretch the stock ... in the plane of the sheet so as to form a planarly drawn or stretched planar laminate paint film sheet ..." Note, the supporting description, page 2, lines 21-22; in the paragraph bridging pages 5-7; page 10, lines 22-24; page 11, line 11, and so forth. See, claim 12 (at least 125% stretching); claim 21 (... the stock sheet is drawn or stretched); claim 22 (... the softened stock sheet is drawn or stretched ...); claim 25 (... the stock sheet ... then is drawn or stretched.).

Peterson and Susa et al. are not combinable because they are in different technical fields. Peterson does not relate to a

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film article, and Susa et al. relates to new formulations for paint films to be molded, not to planar stretching methods.

There is no motivation clearly present in the prior art for the ordinary artisan in the pertinent art of the present claimed invention to combine Peterson and Susa et al. That Peterson's molding method could be used with a Susa et al. composition is insufficient to establish obviousness. Again, Peterson does not disclose stretching of paint films, and Susa et al. discloses no method of stretching but rather use of their new composition in molding. That Peterson's stretching method may be applicable to stretching general films begs the question of where in the prior art is the practical motivation to combine the disclosures of the references, and is based on impermissible hindsight. Obviousness is not equal to that within the capabilities of one skilled in the art. See, Ex parte Gerlach, 212 USPQ 471 (Bd. App. 1980).

It is no misplaced generalization to note that Susa et al. consider "stretching" a problem. It is a fact expressed in the prior art by Susa et al., who were concerned with molding parts, because it caused undesired differing viewing characteristics of the finished product. It is a misrepresentation to state, "some 'small extent' stretching is acceptable." Susa et al. states as background of their invention at column 1, lines 23-30:

"When a matte paint film is formed on a synthetic resin material and then the synthetic resin material is subjected to molding to produce a synthetic resin product, the generation of the [problem in previously known matte paint film that its surface includes portions which appear to be sufficiently matted or conversely to be bright] is significant between a portion stretched to a small extent, or not stretched[,] and a portion stretched to a large extent, and causes a reduction in the value of the synthetic resin product."

Thus, clearly, "stretching" refers to an undesirable adjunct of molding with matte paint films, which was a problem. Again, Susa et al. addressed this problem with a new composition, not a method of stretching paint film sheets.

None of the dependent claims are taught nor suggested by the artificial combination of Peterson and Susa et al.

The Examiner's explanation of PCT article 33(3) not being a grounds for rejection of claim 12 clarifies the record.

Ghosh does not teach nor suggest the claimed 125% stretching of paint film sheet stock, alone or in an artificial combination with Peterson and Susa et al. The current open claim language requires, "a method for forming wide paint film parts," each part within the method that "retains a painted surface finish." See, base claim 10, first and last lines. This is not failure. No

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evidence nor reasoning supports the Examiners' contention that Ghosh suggests that film articles can be stretched to the extent that textiles are stretched and fail in testing. Ghosh has no disclosure of paint film sheet stock stretching, not being concerned with that manufacturing technology. His is a test method. Moreover, that film articles "can" be stretched in a test machine begs the question of where in the prior art is the practical motivation to combine disclosures of the references, and appears to be based on the use of impermissible hindsight. Again, obviousness is not equal to that within the capabilities of one skilled in the art. See, *Gerlach*, 212 USPQ at 471.

Once again, Ghosh relates to testing of textiles by stretching to rupture. No testing of paint film sheet stock was disclosed, much less manufacture of drawn or stretched paint film sheet stock, by Ghosh. The intent of Ghosh is to test textiles by stretching them to the point of failure. This intent cannot be destroyed to render Ghosh applicable art and establish a case of obviousness. See, *In re Gordon*, 733 F.2d 900, 902 [221 USPQ 1125, 1127] (Fed. Cir. 1984). If this failure suggests the present claimed method step to the Examiners, it is only because they must have used the Applicants' disclosure, the only place where the claimed method is found, as if it were prior art. This would constitute the use of improper hindsight.

To apply the whole field of "stretching" is too broad and abstract, and does not accurately represent the practical matters addressed in the pertinent art of the present claims. See, 35 USC 103(a). The pertinent art is where the ordinary artisan gets his motivation, which is practical, not abstract, and is always related to the properties or uses one skilled in the art would expect the structure to have, if made. See, e.g., *In re Newell*, 891 F.2d 899, 901 [13 USPQ2d 1248, 1250] (Fed. Cir. 1989).

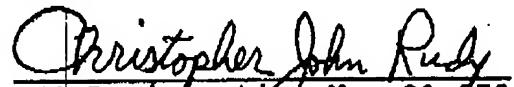
Other Matters

Brief appendices complying with 37 CFR 41.37 are attached.

Conclusion

The Examiners' reasoning remains in serious error. Reversal of the Examiners' rejections, and an allowance, remain in order.

Respectfully,


Christopher John Rudy
PTO Registration No. 31,873
209 Huron Avenue, Suite 8
Port Huron, Michigan 48060
Telephone (810) 982-4221

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Attn: Three appendices

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Claims Appendix p. CA-1

CLAIMS ON APPEAL

10. A method for forming wide paint film parts, which comprises:

providing apparatus for forming wide paint film parts, having a frame; and, attached to the frame, at least two paint film stock grasping members, which generally oppose one another, which can grasp deformable paint film stock, at least one of which can be moved apart from the other while the stock is grasped;

providing deformable paint film stock, which is:

in a form of a discrete, substantially planar sheet,

made of a laminate material including a deformable base having a paint film laminated thereon that provides a painted surface finish, and

able to be itself formed into a part through vacuum or pressure molding;

grasping the stock sheet on generally opposing sides by at least two paint film stock grasping members; and

moving, while the stock is so grasped, the at least one of the at least two paint film stock grasping members apart from the other so as to draw or stretch the stock between the at least two paint film stock grasping members in the plane of the sheet so as to form a planarly drawn or stretched planar laminate paint film sheet that retains a painted surface finish.

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Claims Appendix p. CA-2

11. The method of claim 10, wherein heat is applied to the stock sheet to facilitate stretching.

12. The method of claim 10, wherein the stock sheet is stretched to at least about 125% of at least one of its original dimensions it had before stretching.

20. The method of claim 10, wherein the deformable base of the stock sheet is a thermoformable material.

21. The method of claim 20, wherein the stock sheet is loaded in the apparatus, and the stock sheet is grasped by the paint film stock grasping members through jaws associated with said members; then the stock sheet in the loaded apparatus is softened by heating; and then the stock sheet is drawn or stretched.

22. The method of claim 21, wherein the softened stock sheet is drawn or stretched along at least two non-parallel axes in the plane.

23. The method of claim 22, wherein the stock sheet is substantially rectangular or square.

24. The method of claim 23, wherein two of the at least two non-parallel axes are substantially orthogonal to one another.

25. The method of claim 24, wherein the stock sheet and apparatus loaded with it is moved into an oven for heating, and then is drawn or stretched.

26. The method of claim 10, wherein the drawn or stretched planar laminate paint film sheet is further subject to vacuum or pressure molding to form a three dimensional wide paint film stock part.

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Claims Appendix p. CA-3

27. The method of claim 26, wherein the drawn or stretched planar laminate paint film sheet is substantially cooled before it is further subject to the molding.

28. The method of claim 26, wherein a mold is moved into position with respect to the drawn or stretched planar laminate paint film sheet to subject it to the molding, without substantial cooling of the drawn or stretched planar laminate paint film sheet.

29. The method of claim 22, wherein the drawn or stretched planar laminate paint film sheet is further subject to vacuum or pressure molding to form a three dimensional wide paint film stock part.

30. The method of claim 29, wherein the drawn or stretched planar laminate paint film sheet is substantially cooled before it is further subject to the molding.

31. The method of claim 29, wherein a mold is moved into position with respect to the drawn or stretched planar laminate paint film sheet to subject it to the molding, without substantial cooling of the drawn or stretched planar laminate paint film sheet.

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Evidence Appendix, p. EA-1

EVIDENCE UNDER 37 CFR 1.130, 1.131, 1.132

NONE

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RELATED PROCEEDINGS

NONE